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10/531,259	04/24/2006	Gisela Meister	MEIS3002/JEK	4669
23364 7590 08/27/2008 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
DOAN, TRANG T				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,259

Applicant(s)

MEISTER ET AL.

Examiner

TRANG DOAN

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date 04/05 and 04/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-14 are pending for consideration.

Information Disclosure Statement

2. The information disclosure statements filed on 04/13/2005 and 04/29/2008 are being considered by the examiner.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Objections

4. Claims 1, 10 and 14 are objected to because of the following informalities:
Regarding claims 1, 10 and 14, please correct the phrase "vis-a`-vis" because it is not in English language.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 10, Examiner confuses what Applicant means by the limitation "comprising locating via the portable data carrier quality information about how the authentication of the user was done". Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3-8, 10, 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Mimura et al. (US 7162058) (hereinafter Mimura).

Regarding claim 1, Mimura discloses a method for effecting a secure electronic transaction on a terminal using a portable data carrier, whereby a user authenticates himself vis-a-vis the portable data carrier (Mimura: See figure 1 items 100, 102 and 103), the portable data carrier confirms the proof of authentication to the terminal (Mimura: column 10 lines 50-62; column 11 lines 4-11; column 11 line 64 through column 12 line 7), and the portable data carrier then performs a security-establishing

operation within the electronic transaction, comprising locating via the portable data carrier quality information about how the authentication of the user was done and attaching said quality information to the result of the security-establishing operation (Mimura: column 6 lines 39-54).

Regarding claim 3, Mimura discloses wherein the authentication of the user is performed by presentation of a biometric feature (Mimura: See figure 1 item 102).

Regarding claim 4, Mimura discloses wherein the authentication of the user is performed by presentation of a physiological or behavior-based feature characteristic of a user (Mimura: column 2 lines 35-41).

Regarding claim 5, Mimura discloses wherein the authentication of the user is performed by proof of knowledge of a secret (Mimura: column 6 lines 44-48).

Regarding claim 6, Mimura discloses wherein at least two different authentication methods of different quality are offered for authentication of the user (Mimura: See figure 1 items 102 and 103).

Regarding claim 7, Mimura discloses wherein the particular authentication methods not used are disabled (Mimura: column 4 line 57 through column 5 line 4).

Regarding claim 8, Mimura discloses wherein no quality information is produced for an authentication method (Mimura: See figure 1 and figure 16; column 11 lines 4-11).

Regarding claim 10, Mimura discloses a portable data carrier for performing a security-establishing operation within a secure electronic transaction, whereby a user authenticates himself vis-a-vis the portable data carrier and the portable data carrier

confirms the authentication to a terminal, comprising setting up the data carrier to create quality information stating how the authentication of the user was performed (Mimura: column 6 lines 39-54; column 10 lines 50-62; column 11 lines 4-11; column 11 line 64 through column 12 line 7).

Regarding claim 12, this claim has limitations that is similar to those of claim 6, thus it is rejected with the same rationale applied against claim 6 above.

Regarding claim 14, Mimura discloses a system for effecting a secure electronic transaction within which the quality of authentication of a user vis-a-vis the system is ascertained, comprising a portable data carrier according to claim 10 and a terminal according to claim 13 (Mimura: See figure 1).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mimura in view of Barlow et al. (US 6810479) (hereinafter Barlow).

Regarding claim 2, Mimura does not disclose wherein the security-establishing operation performed by the portable data carrier comprises creating a digital signature. However, Barlow discloses wherein the security-establishing operation performed by the portable data carrier comprises creating a digital signature (Barlow: See figure 9;

column 6 lines 3-7; column 12 lines 49-55; column 15 lines 30-44; column 16 lines 23-45). Therefore, it would have been obvious to a person skilled art at the time the invention was made to have included in Mimura the feature of Barlow as discussed above because encryption, decryption, digital signing, and verification are therefore the principal cryptographic primitives that are used in an electronic network setting to facilitate the security, privacy, authenticity, and integrity of information being exchanged (Barlow: column 3 lines 45-49).

Regarding claim 11, this claim has limitations that is similar to those of claim 2, thus it is rejected with the same rationale applied against claim 2 above.

11. Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mimura in view of Foley et al. (US 20020087894) (hereinafter Foley).

Regarding claim 9, Mimura does not disclose wherein a user is asked to select an authentication method. However, Foley discloses wherein a user is asked to select an authentication method (Foley: paragraphs 0010; 0026-0028). Therefore, it would have been obvious to a person skilled art at the time the invention was made to have included in Mimura the feature of Foley as discussed above because existing systems, however, are limited to pre-defined security features and procedures and generally require that a merchant initiate changes to accommodate each different smart card or wallet. Thus, a new system of accessing a restricted service (e.g., conducting electronic transactions) is desired which would allow the user to select the method of authentication and provide improved security with minimal overhead for users and merchants (Foley: paragraph 0009).

Regarding claim 13, this claim has limitations that is similar to those of claim 9, thus it is rejected with the same rationale applied against claim 9 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRANG DOAN whose telephone number is (571)272-0740. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Trang Doan/
Examiner, Art Unit 2131

/Ayaz R. Sheikh/
Supervisory Patent Examiner, Art Unit 2131